

REMARKS

The present application has been considered in view of the Final Office Action that was mailed on July 21, 2009, and the Advisory Action that was mailed on September 30, 2009. Claims 10-34 are currently pending. By the present Amendment, Applicants have amended claims 10-25, and added new claims 29-34 for consideration. Applicants respectfully submit that the amendments to claims 10-25 effected herein, and the addition of new claims 29-34, do not introduce any new matter, and are fully supported by the specification. In view of the following remarks and arguments, Applicants respectfully submit that each of pending claims 10-34 is allowable over the references of record, and accordingly, respectfully request reconsideration and allowance of these claims.

In the Final Office Action, claims 10, 14-16, 19, and 21-28 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,573,540 to Yoon (hereinafter "Yoon"). However, in an Amendment Under 37 C.F.R. §1.116 that was filed on September 21, 2009 (hereinafter "the Amendment") in response to the Final Office Action, with respect to Yoon, Applicants pointed out that "following proximal retraction of the closure apparatus 310, the forceps 341 are introduced to grasp the free ends 339 of the suture material 325," (Amendment of September 21, 2009, page 10) (*see also* col. 9, lines 47-53), and that "Yoon is devoid of any disclosure, either in the written description or in the figures, that would allow one of ordinary skill in the art to reasonably conclude that the forceps 341 are a component of the apparatus 310." (Amendment of September 21, 2009, pages 10-11). Continuing, Applicants emphasized that "[t]he forceps 341 are not attached or connected to the apparatus 310 in any way, shape, or form, and constitute

an entirely separate, distinct surgical instrument altogether” and that “[a]ny conclusion to the contrary is simply unsupported by Yoon.” (Amendment of September 21, 2009, page 11)

In reply, it was stated in the Advisory Action that “[t]he applicant argues that Yoon’s jaw members 341 are not attached or connected to the apparatus 310 in any way, shape, or form and thus Yoon fails to disclose the applicant’s invention as recited in the claims,” but that “the claims merely require the two jaw members be adjacent to the tissue engaging members and being movable independently thereof,” and that “[n]owhere do the claims require the jaw members being “attached to” or “connected to” any of the elements recited in the claims.” (Advisory Action, page 2).

While Applicants maintain that the subject matter recited in claims 10, 14-16, 19, and 21-28 was patentably distinct from the subject matter of the Yoon disclosure, as presented previously in the Amendment, in the interests of advancing prosecution, Applicants have amended the claims herein to more precisely define the structural differences between the claimed “apparatus” and the subject matter described in Yoon.

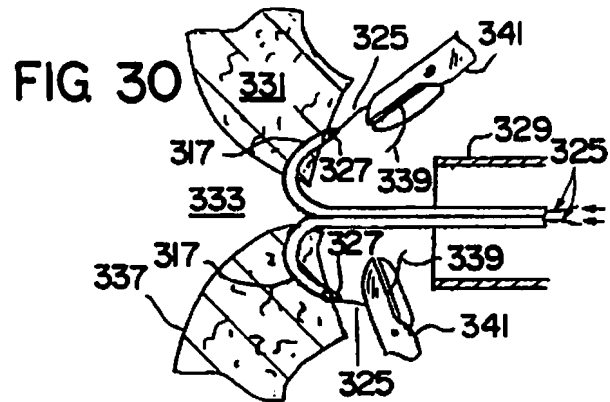
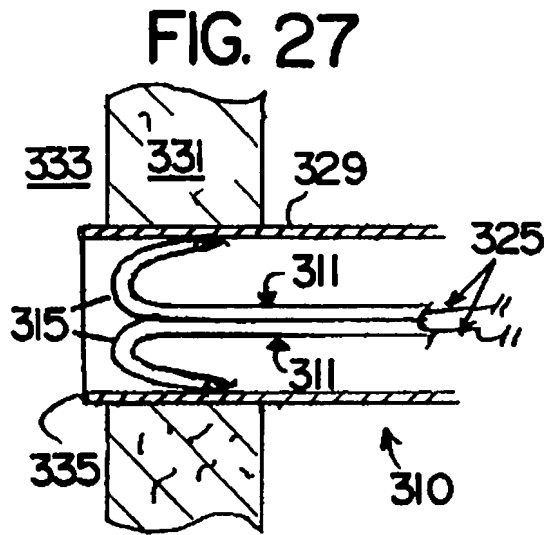
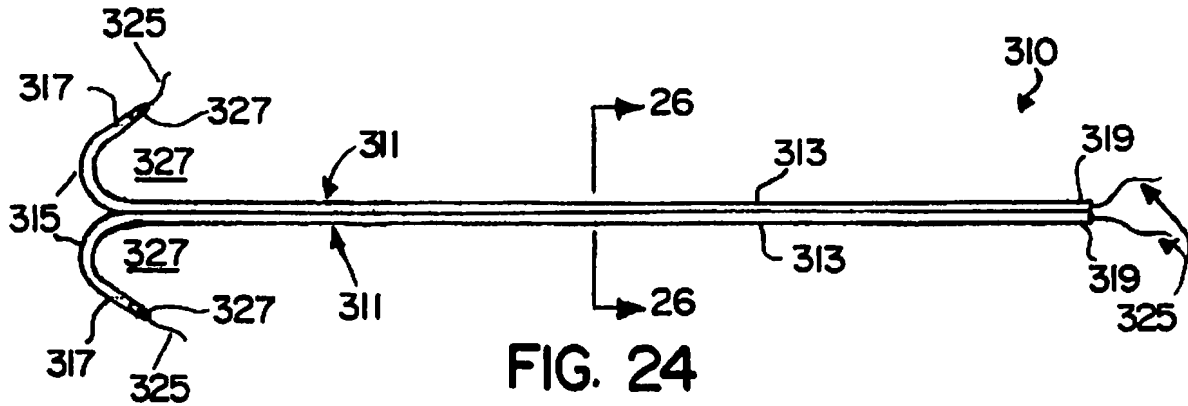
Under MPEP § 2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

As amended, independent claim 10 recites “[a]n apparatus for substantially closing a vascular opening in a vessel while permitting post operative blood flow through said vessel” that includes “a housing,” “at least two tissue engaging members disposed adjacent the distal end of the housing, said tissue engaging members

being longitudinally and reciprocally movable relative to said housing between a retracted position and an advanced position,” and “at least two jaw members connected to the housing and positioned adjacent said tissue engaging members and being movable independently thereof.”

As amended, independent claim 25 recites “[a]n apparatus for substantially closing a vascular opening in a vessel while permitting post operative blood flow through said vessel” that includes “a housing,” “a pair of tissue engaging members at least partially extending from the housing, the pair of tissue engaging members being longitudinally and reciprocally movable relative to said housing between a retracted position and an advanced position,” and “a pair of jaw members connected to the housing and disposed adjacent the tissue engaging members.”

As previously described in the Amendment, Yoon’s closure apparatus 310 includes two or more outwardly turned hooks 311 each having a hollow leg 313 that allows a length of suture material 325 to pass therethrough. (*See* col. 8, line 62 – col. 9, line 11; FIG. 24 below). According to Yoon, during use, a portal sleeve or cannula 329 is positioned within the wall 331 of an anatomical cavity 333 through a puncture site, whereby the sleeve 329 acts as a housing or portal for passage of medical instruments into the anatomical cavity 333. (*See* col. 9, lines 25-32; FIG. 27 below). Following passage through the sleeve 329, the closure apparatus 310 is retracted proximally to cause the tips 317 of the legs 313 to penetrate into the tissue of the cavity wall 331 surrounding the puncture site, and the suture material 325 is grasped using forceps 341, or the like. (*See* col. 9, lines 43-53; FIG. 30 below).



To reiterate, in the Final Office Action, the sleeve 329, the hooks 311, and the forceps 341 were respectively characterized as the claimed “housing,” “tissue engaging members,” and “jaw members.” (See Final Office Action, pages 2-3). This characterization was maintained in the Advisory Action.

Contrary to the “jaw members” recited in amended independent claims 1 and 25, which are “connected to the housing,” as discussed in the Amendment, the forceps 341 are not attached or connected to the apparatus 310 in any way, shape, or form, and constitute an entirely separate and distinct surgical instrument altogether.

Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that Yoon fails to disclose each and every element recited in amended independent claims 10 and 25, and therefore, that Yoon fails to anticipate the subject matter of amended independent claims 10 and 25. As such, Applicants respectfully submit that amended independent claims 10 and 25 are allowable over Yoon under 35 U.S.C. §102(b). Since claims 14-16, 19, 21-24, and 26-28 depend either directly or indirectly from amended independent claims 10 and 25, and include each element recited therein, for at least the reasons that amended independent claims 10 and 25 are allowable over Yoon under 35 U.S.C. §102(b), *inter alia*, Applicants respectfully submit that claims 14-16, 19, 21-24, and 26-28 are also allowable over Yoon under 35 U.S.C. §102(b).

In the Final Office Action, claims 11-13, 17, 18, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yoon. This rejection was maintained in the Advisory Action. Applicants respectfully submit, however, that Yoon fails to render the subject matter of claims 11-13, 17, 18, and 20 obvious.

As a condition for patentability, 35 U.S.C. §103(a) indicates that “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art,” then the subject matter is not patentable. (Emphasis added).

In the Final Office Action, it was acknowledged that Yoon fails to disclose the incorporation of a “shape memory material,” as recited in claim 11, or “conductive” materials, as recited in claims 17 and 18, but it was argued that such materials are well known in the art, and that their inclusion would have been obvious to one of ordinary

skill in the art. (*See* Final Office Action, page 4). Additionally, regarding claim 20, it was acknowledged that Yoon fails to disclose a “spring member . . . to bias said jaw members towards the closed position,” as recited in claim 20, and it was again argued that such structure is known in the art, and that the inclusion thereof would have been obvious to one of ordinary skill in the art. (*See* Final Office Action, pages 4-5).

As previously discussed, Yoon fails to disclose an “apparatus for substantially closing a vascular opening in a vessel” that includes “a housing,” “tissue engaging members,” and “jaw members” that are “connected to the housing,” as recited in amended independent claim 10.

Assuming, *arguendo*, that the arguments set forth in the Final Office Action regarding the knowledge of one of ordinary skill as it pertains to “shape memory material,” “conductive” materials, and a “spring member . . . to bias said jaw members towards the closed position,” are accurate, the incorporation of one or more of these features would fail to cure the aforescribed deficiencies in Yoon.

Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that Yoon fails to suggest the subject matter of amended independent claim 10 as a whole, and therefore, that Yoon fails to render the subject matter of amended independent claim 10 obvious. As such, Applicants respectfully submit that amended independent claim 10 is allowable over Yoon under 35 U.S.C. §103(a). Since claims 11-13, 17, 18, and 20 depend either directly or indirectly from amended independent claim 10, and include each element recited therein, for at least the reasons that amended independent claim 10 is allowable over Yoon under 35 U.S.C. §103(a), *inter alia*,

Applicants respectfully submit that claims 11-13, 17, 18, and 20 are also allowable over Yoon under 35 U.S.C. §103(a).

Claim 10 was also rejected in the Final Office Action on the ground of non-statutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,248,124 (hereinafter “the ‘124 patent”). This rejection was maintained in the Advisory Action.

In response, and in the interests of advancing prosecution, Applicants will execute a terminal disclaimer with respect to claim 1 of the ‘124 patent upon the indication that claim 10 is otherwise allowable.

As mentioned earlier, new claims 29-34 have been added for consideration. Applicants respectfully submit that these claims recite a unique combination of features that is neither taught, nor suggested, by the references of record. For example, as discussed above, the references of record do not disclose, or even suggest, “[a]n apparatus” that includes “a housing,” “tissue engaging members,” and “jaw members” that are “connected to the housing,” as recited in new independent claim 29.

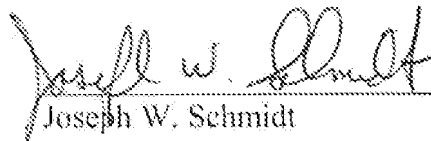
Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that new independent claim 29 is allowable over the references of record. Since new claims 30-34 depend either directly or indirectly from new independent claim 29, and include each element recited therein, for at least the reasons that new independent claim 29 is allowable, *inter alia*, Applicants respectfully submit that new claims 30-34 are also allowable.

In view of the foregoing remarks and arguments, Applicants respectfully submit that claims 10-34 are allowable over the references of record, and accordingly, respectfully request allowance of these claims.

Should the Examiner have any questions concerning this Amendment, or feel that an interview would be helpful in resolving any outstanding matters, the Examiner is sincerely invited to contact Applicants' undersigned attorney at the number indicated below.

Please charge any deficiency, as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550. Also, in the event that any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required, and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,



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